

### **REMARKS**

This paper is presented in response to the Office Action. By this paper, claims 19-29 are canceled, and claim 10 is amended. Claims 1-18 and 20-34 are now pending in light of the aforementioned cancellations.

Reconsideration of the application is respectfully requested in view of the following remarks. For the convenience and reference of the Examiner, the remarks are presented in the order in which the corresponding issues were raised in the Office Action.

#### **I. General Considerations**

Applicant notes that the remarks presented herein have been made merely to clarify the claimed embodiments from elements purported by the Examiner to be taught by the cited references. Such remarks, or a lack of remarks, are not intended to constitute, and should not be construed as, an acquiescence, on the part of the Applicant: as to the purported teachings or prior art status of the cited references; as to the characterization of the cited references advanced by the Examiner; or as to any other assertions, allegations or characterizations made by the Examiner in this case. Applicant reserves the right to challenge the purported teaching and asserted prior art status of the cited references at any appropriate time.

In addition, the remarks herein do not constitute, nor are they intended to be, an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed herein are presented solely by way of example.

#### **II. Claim Rejections Under 35 U.S.C. §103(a)**

Applicant respectfully notes at the outset that in order to establish a *prima facie* case of obviousness, it is the burden of the Examiner to demonstrate that three criteria are met: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See M.P.E.P. § 2143.

The Examiner has rejected claims 1-34 under 35 U.S.C. § 103(a) as being unpatentable over US 5,537,504 to Cina et al. ("Cina") in view of US 6,445,939 to Swanson et al. ("Swanson") or US 5,757,830

to Liao et al. ("*Liao*") For at least the reasons outlined below however, Applicant respectfully disagrees with the Examiner and submits that the rejection of those claims should be withdrawn.

In rejecting the claims, the Examiner has alleged that "*Cina* et al. ... discloses ... a lens of plastic material positioned in housing between the face of the optical fiber and the optoelectronic converter [and] ... *Cina* et al differs from the claimed invention because he does not explicitly disclose fiber stop (i.e., lens) has an index of refraction approximately the same as the index of refraction of a core of the optical fiber as claimed." *Emphasis added.*

**a. claims 1-9**

As indicated above, it appears that the Examiner has characterized the "lens 3" of *Cina* as corresponding with the claimed "fiber stop." However, Figure 1 of *Cina* makes clear that the "lens 3" does not serve as a fiber stop. With regard to Figure 1, *Cina* instead discloses that "The bore 5 has a tapered entrance 10 and a diameter dimension related to the outside diameter of the ferrule 6 so as to retain the optical fiber face 9 against the shoulder 11 in a friction fit." *Col. 4, lines 36-39. Emphasis added.* It would thus appear from *Cina* that the shoulder 11, and not the lens 3, serves as a fiber stop. Accordingly, even if the *Cina* device is modified to include the alleged teachings of *Swanson* and/or *Liao* in the purportedly obvious fashion, the resulting combination nonetheless fails to include all the limitations of claim 1, and of corresponding dependent claims 2-9.

Additionally, *Cina* appears in any event to counsel against employment of the lens 3 as a fiber stop. For example, *Cina* states that "surface 21 [of lens 3] provides focus at the face 9 of the optical fiber in a range along the Z axis that accommodates for placement variation of the lens 3, the optoelectronic converter 4 and the optical fiber face 9. This can be viewed as giving a wide tolerance range for the placement of the optoelectronic converter within its optoelectronic package 19." *Col. 6, lines 50-56.* In view of this disclosure, it would seem that moving the lens 3 to a position where the lens 3 would serve as a fiber stop for optical fiber face 9 would be undesirable inasmuch as such an arrangement would significantly reduce the aforementioned "wide tolerance range."

Moreover, *Cina* specifically discloses, with respect to the relative arrangement of lens 3 and fiber face 9 of Figure 4, that "Range 27, extending from point T to point H, represents the section of the optical axis N over which soft focus is achieved, and it is substantially within this range that the face 9 of the optical fiber is placed." *Col. 7, lines 46-49. Emphasis added.* As Figure 4 of *Cina* indicates, the range 27 is separated some distance from the nearest portion (surface 21) of lens 3. In view of this disclosure,

there would appear to be no motive to modify the *Cina* device in such a fashion as to arrive at the claimed invention.

Finally, modification of the *Cina* device such that the lens 3 is moved to a position where the lens 3 would serve as a fiber stop for optical fiber face 9 is problematic for at least one other reason as well. Particularly, it was noted above that *Cina* discloses a range 27 within which, according to *Cina*, the face 9 must be positioned to obtain the disclosed “soft focus.” In light of this disclosure, and in view of Figure 4 of *Cina*, it would appear that movement of the lens 3 into a position where that lens 3 would serve as a fiber stop would move the position of focused light out of the range 27 and thereby impair, if not completely prevent, achievement of the stated “soft focus” effect.

As discussed above, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 1-9, at least because the Examiner has not established the existence of a motivation or suggestion to combine reference teachings in the purportedly obvious fashion, and because the references, even when combined, fail to disclose all the limitations of those claims.

**b. claims 10-18**

Independent claim 10 is somewhat similar to claim 1 inasmuch as claim 10 requires a “means for stopping a received optical fiber ... wherein said means ... has an index of refraction approximately equal to an index of refraction of the received optical fiber.” For at least the reasons outlined above in connection with the discussion of claim 1 however, Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 10-18, and Applicant thus respectfully directs the attention of the Examiner to such discussion. In view of such discussion, Applicant respectfully submits that the rejection of claims 10-18 should be withdrawn.

**c. claims 19-29**

In view of the fact that claims 19-29 are cancelled herein, Applicant submits that the rejection of those claims has been rendered moot and should accordingly be withdrawn.

**d. claims 30-34**

Independent claim 30, from which claims 31-34 depend, recites a “coupler comprising: a sleeve; a window situated at a first end of said sleeve; and a lens situated at a surface of said window opposite of a surface of said window proximate to said sleeve.” However, the Examiner has not even asserted, much less established, that any of the cited references, either alone or in combination, teach or suggest the

combinations respectively recited in claims 30-34. Applicant accordingly submits that the rejection of those claims should be withdrawn.

**III. Amendment to Claim 10**

Applicant notes that the amendment herein to claim 10 has not been made in response to any rejection or objection posed by the Examiner, but rather simply to refine the language of that claim. In this regard, it should be noted that Applicant has broad discretion to choose and modify the language of a claim and, moreover, various patentable expressions of comparable claim scope lie within the bounds of such discretion. Because the amendment to claim 10 falls within the bounds of that discretion, such amendment is not related to patentability of that claim.

**IV. Docket Number**

Applicant respectfully notes that the Office Action incorrectly references Attorney Docket No. "H0004037 (1139.1128101)." Pursuant to the Change of Attorney Docket Number filed in this case on April 16, 2004, the correct docket number for this case is 15436.441.6. Applicant thus respectfully requests that all applicable USPTO records be updated accordingly, and Applicant further requests that all further communications from the USPTO reference docket number 15436.441.6.

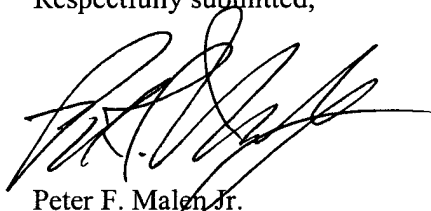
Application No. 10/620,512  
Docket No. 15436.441.6  
Reply to Office Action mailed May 11, 2005

**CONCLUSION**

In view of the remarks submitted herein, Applicant respectfully submits that each of the pending claims 1-18 and 20-34 is in condition for immediate allowance. Therefore, reconsideration of the rejections is requested and allowance of those claims is respectfully solicited. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate the same with the undersigned attorney.

Dated this 11<sup>th</sup> day of October, 2005.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Peter F. Malen Jr.", written in a cursive style.

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